

REMARKS

In the Final Office Action,¹ the Examiner:

- 1) objected to the specification,
- 2) rejected claims 1, 4-13, 16-25, 28-37, and 40-56 under 35 U.S.C. § 112, first paragraph,
- 3) rejected claims 1, 4-13, 16-25, 28-37, 40-49, 51, 53 and 55 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,422,821 to *Allen*, and
- 4) rejected claims 50, 52, 54, and 56 under 35 U.S.C. § 103 as unpatentable over *Allen* in view of U.S. Patent No. 5,422,821 to *Cordery*.

Claims 1, 4-13, 16-25, 28-37, and 40-56 remain pending.

As a preliminary matter, the Examiner refers to an "Adam" reference on page 14 of the Final Office Action. For purposes of responding, Applicants assume this should have read "Allen." Applicants request the Examiner's clarification if this assumption is not correct.

Applicants respectfully traverse the objection to the specification and the rejection of claims 1, 4-13, 16-25, 28-37, and 40-56 under 35 U.S.C. § 112, first paragraph. Applicants have added no new matter to the specification. The specification is enabling for the amendments made October 5, 2007. Applicants note that "[w]hile there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." M.P.E.P. § 2163 In addition "[a]n applicant shows possession of the claimed invention

by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.” M.P.E.P. § 2163.02.

With respect to “a second instance of the incorrect address,” one of ordinary skill in the art would be enabled to make or use at least this portion of the claimed invention by reference to, for example, paragraphs 22 and 48 of the specification. Paragraph 22 discloses that:

[i]tem 110 may be routed through delivery system 130 . . . The plants within delivery path 135 may contain, among other things, automated systems and sorting equipment and are designed to receive and process a plurality of items.

Paragraph 28 discloses that:

the delivery system operator may process data from address label 115 through one of a plurality of address resolution processes in order to obtain correct address for item 110. However, if data from address label 115 had been previously resolved, a database containing the resolved address including a correct address record and an incorrect record may produce the correct address through a data base query. In this case, the correct address may be produced without having to use one of the plurality of address resolution processes to resolve the address a second time.

Other examples of enabling disclosure can be found at, for example, paragraphs 8, 9, and 58.

Accordingly, the claim amendment cited by the Examiner is fully enabled in accordance with 35 U.S.C. § 112, first paragraph. Therefore, the rejection should be

1 The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

withdrawn. Since the claim amendment does not introduce new matter, the objection to the specification should also be withdrawn.

Applicants respectfully traverse the rejection of 1, 4-13, 16-25, 28-37, 40-49, 51, 53 and 55 under 35 U.S.C. § 103. No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, the Examiner must, among other things, determine the scope and content of the prior art and ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A), 8th Ed., Rev. 6 (September 2007). Furthermore, the Examiner must make findings with respect to all of the claim limitations and must make “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

See M.P.E.P. §§ 2143.03 and 2141(III).

Claim 1 recites, *inter alia*, “comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address.”

The Examiner alleges that “receiving a second instance of the incorrect address” and “comparison of a second instance of the incorrect address” is “merely a re-checking step.” Final Office Action, page 4. The Examiner also alleges that “it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to modify the system of Allen to include receiving a second instance of the incorrect address and performing a comparison in order to repeat the address correction process for any subsequent mail pieces addressed to the same receiver.” Final Office Action, pages 4-5. These allegations do not render claim 1 obvious.

Claim 1 does not “repeat the address correction process for any subsequent mail pieces,” as argued by the Examiner. Instead the claim recites “comparing the second instance of the incorrect address to the stored resolved address.” *emphasis added*. That is, the “comparison” step, as claimed, does not invoke a repetition of the address correction process, as alleged by the Examiner.

Also, “receiving a second instance of the incorrect address” and “comparison of a second instance of the incorrect address” is not “merely a re-checking step,” as alleged by the Examiner in the Final Office Action at page 4. The “receiving” and “comparing” steps ultimately lead to a “determination” that allows for “outputting the correct address,” as claimed. Therefore, “mere” “re-checking” would not result in the claimed combination of “receiving,” “comparing,” and “outputting,” as claimed.

For at least these reasons, the Final Office Action fails to establish a *prima facie* case of obviousness with respect to claim 1, at least because the prior art fails to teach each and every element required by the claim. Therefore, the rejection should be withdrawn.

Regarding the rejection of claims 50, 52, 54, and 56, the Examiner alleges that *Cordery* teaches a method “when the incorrect address does not match the stored first instance of the incorrect address.” Final Office Action, page 13. Even assuming that this allegation is true, which Applicants do not concede, *Cordery* fails to cure the deficiencies of *Allen* discussed above. That is, *Cordey* does not teach or suggest the combination of “receiving,” “comparing,” and “outputting,” as claimed.

In view of the mischaracterization of the prior art and of the claims, the Final Office Action has neither properly determined the scope and content of the prior art nor

properly ascertained the differences between the prior art and the claimed invention.

Accordingly, findings have not been made, and reasons have not been clearly articulated, as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Accordingly the prior art fails to establish a *prima facie* case of obviousness with respect to claims 50, 52, 54, and 56, at least because the prior art fails to teach each and every element required by the claim.

Claims 13, 25, and 37, though of different scope from claim 1, recite elements similar to those set forth above for claim 1. Claims 13, 25, and 37 are therefore allowable for at least the reasons presented above with respect to claim 1. Claims 4-12, 16-14, 28-36, and 40-56 respectively depend from claims 1, 13, 25, and 37 and are allowable at least for the reason of their dependency. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 103.

In view of the foregoing remarks, Applicants submit that the claims are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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